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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,341	04/20/2001	Takahiro Hayashi	Q64162	1065

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2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,341

Applicant(s)

HAYASHI ET AL.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,9-12,16,20-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,9-12,16,20-24,26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment of 1/13/05 has been entered. The examiner will address applicant's remarks at the end of this office action. Currently claims 1,3,9-12,16,20-24,26-28 are pending.

1. Claims 21,22,23,24, are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant has added the claimed limitations to claim 20 so these claims are reciting nothing further to the claimed invention and are verbatim to portions of claim 20.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3,9-12,16, are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (6430496).

For claims 1,9,10,12,16, Smith discloses a transportation method and system as claimed. Smith discloses a plurality of vehicles 20 that each have their own mandatory terminal. The mandatory terminals of the vehicles have transmission means that allows

data/information to be transmitted to and from the order receiving server 10. The transmission means is shown in Smith as communication link 22 (and 24,18). The order receiving server has a means for receiving and transmitting data/information to and from the mandatory terminals. This means can be interpreted to be 24,18, and/or 22. The order receiving server also has means to receive order information from an ordering terminal 14 and to transmit information to the ordering terminal 14. This occurs via communication line 15. The ordering terminal can also transmit information to the server via line 15. Smith also discloses a means to specify the closest vehicle as claimed. See for example, column 8, line 21 ("closest vehicle request"), column 13, lines 41-48 ("N closest vehicles"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). The mandatory terminal, the order receiving server, and the ordering terminals are fully capable of and are disclosed as transmitting and receiving the claimed information. With respect to the language reciting that the order and delivery information include an electronic mail address, this is considered to be non-functional descriptive material that does not serve as a limitation. This limitation is just describing the kind of information being transmitted and does not define anything further to the system itself. The mandatory terminals can transmit information to a customer terminal via the server system 10 and this satisfies the last paragraph of the claim.

For claims 3,12, the control means is interpreted to be the on or off switch that the mandatory terminals will inherently have. The claimed "only in a desired period" is taken to be the working hours of the vehicle. When the terminal is not on, it will not

Art Unit: 3629

transmit anything and when it is on and the vehicle is in use, the terminal is capable of transmitting.

For claim 11, the examiner does not see how this claim further adds anything to the transportation system of claim 1, other than reciting an intended use of the system.

Smith is fully capable of being used by a company with round the clock operation.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 20-24,26-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (6430496) in view of Stephens (6323782).

For claims 20-24,26,27, Smith discloses the invention substantially as claimed. Smith discloses a transportation method and system as claimed. Smith discloses a plurality of vehicles 20 that each have their own mandatory terminal. The mandatory terminals of the vehicles have transmission means that allows data/information to be transmitted to and from the order receiving server 10. The transmission means is shown in Smith as communication link 22 (and 24,18). The order receiving server has a means for receiving and transmitting data/information to and from the mandatory terminals. This means can be interpreted to be 24,18, and/or 22. The order receiving server also has means to receive order information from an ordering terminal 14 and to transmit information to the ordering terminal 14. This occurs via communication line 15. The ordering terminal can also transmit information to the server via line 15. Smith also discloses a means to specify the closest vehicle as claimed. See for example, column 8, line 21 ("closest vehicle request"), column 13, lines 41-48 ("N closest vehicles"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). The mandatory terminal, the order receiving server, and the ordering terminals are fully capable of and are disclosed as transmitting and receiving the claimed information. The mandatory terminals can transmit information to a customer terminal via the server system 10. Smith discloses that each vehicle transmits its current location to the server and the server receives this information. A customer transmits ordering information from the ordering terminal to the server. The server can issue a closest vehicle request to located the N closest vehicles to the order location. Once a vehicle is identified that will process the order request the relevant information is

Art Unit: 3629

transmitted to the vehicle so that the driver knows where to do and what to do. Smith discloses that transportation start and completion information is transmitted as claimed and this data is saved in a file. Applicant is encouraged to read the entire disclosure of Smith but attention is also specifically directed to the following portions of the disclosure: column 11, lines 10-11; column 8, lines 57-61; column 9, lines 36-38; column 4, lines 61-64; column 13, lines 41-48; column 16, lines 38-65; column 17, lines 30- column 18, line 16; column 25, lines 48-64; column 8, line 21 ("closest vehicle request"), and column 25, lines 1-10 ("which indicates the closest vehicles requested by the dispatching process"). Smith discloses that the customer of the transportation service can be notified of completion of the transportation service via an electronic invoice that does not require postage (see column 21, lines 10-50). This inherently requires the receiving of some address information. Smith does not specifically state that electronic email is used. Stephens discloses a transportation method and system where the customer of a transportation service request is notified of the completion of the request by using electronic email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electronic email as the medium to transmit the electronic invoice of Smith to the customer as is disclosed by Stephens so that the customer is notified of the completion of the work and how much it cost.

For claim 28, the examiner does not see how this claim further adds anything to the transportation system method of claim 20, other than reciting an intended use of the system. Smith is fully capable of being used by a company with round the clock

Art Unit: 3629

operation. Reciting the hours a store is open that may utilize the invention of Smith will not be considered a feature that will distinguish over Smith.

6. Applicant's arguments filed 1/13/05 have been fully considered but they are not persuasive.

With respect to the examiner initialing the references on the IDS, the examiner has considered the references in view of the statement of relevancy and the references have been considered in the same manner as other documents in Office search files are considered while conducting a search of the prior art.

With respect to the argument that Smith does not disclose the means for specifying the closest vehicle to a business location (the location of the service request), the examiner disagrees and refers applicant to the rejection of record. Upon a reading of the Smith Patent, one will find more than one place where this is discussed. The examiner has cited some portions of Smith and encourages applicant to read the entire reference.

With respect to the argument for claim 1 that no start and completion information is being sent from the vehicle to the AVL, the examiner reminds applicant that claim 1 is an article claim, not a method claim so no actual step of transmitting anything is required. Also, all that is claimed and the limitation being argued is a means for receiving information at the server from the mandatory terminals. This feature is found in Smith because Smith has a means to transmit information from the vehicles to the server. Applicant seems to be arguing a method step for the article claims.

Concerning the 103 rejection, applicant has presented no new argument for the rejection and the examiner takes this as applicant's agreement that if Smith is found to be a properly applied reference, the 103 rejection using Stephens (for the email limitation) is proper. Applicant has not presented any rebuttal to the obviousness statement found in the 103 rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER